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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,310	12/28/2001	Giuseppe Marchionni	108910-00047	2890

4372 7590 10/06/2004

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WASHINGTON, DC 20036

EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/028,310

Applicant(s)

MARCHIONNI ET AL.

Examiner

Julian Mercado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) 5 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 5 and 20 are objected to because of the following informalities:

- a. In claim 5 at line 5, "propylencarbonate" requires changing to --propylene carbonate--.
  - b. Claim 20 refers back to claim 1 and claim 8 in the preamble, but does not state if this dependency is to be interpreted together, i.e. by use of the function word "and", or if this dependency is to be interpreted in the alternative, i.e. by use of "or". It is suggested to amend claim 20 in accordance with either an "and" or "or" clause.
  - c. In claim 20 at line 3, "range" requires changing to --range of--.
- Appropriate correction is required.

### ***Remarks***

This Office action is responsive to applicant's amendment filed July 16, 2004.

Claims 1-21 are pending.

### ***Claim Rejections - 35 USC § 101***

The rejection of claim 15 under 35 U.S.C. 101 for being an improper definition of a process has been withdrawn.

***Claim Rejections - 35 USC § 102***

The rejection of claim 17 under 35 U.S.C. 102(e) based on Marchionni et al. (U.S. Pat. 6,403,539 B1) has been obviated. The examiner notes applicant's amendment to claim 17 which, by virtue of its dependency from claim 19, is now limited to a  $\text{Li}^+$  cation. Marchionni et al. was relied upon in the prior Office action to read on the instant formula (I) to the extent that the ionic form of M is  $\text{Na}^+$ .

***Claim Rejections - 35 USC § 103***

The rejection of claims 1, 2 and 8-16 under 35 U.S.C. 103(a) based on Marchionni et al. and Mussell et al. (U.S. Pat. 5,882,810) has been obviated.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as U.S. Pat. 5,882,810 at the time this invention was made. Accordingly, U.S. Pat. 5,882,810 is disqualified as prior art through 35 U.S.C. 102(e), (f) or (g) in any rejection under 35 U.S.C. 103(a) in this application.

***Double Patenting and Terminal Disclaimer***

The terminal disclaimer filed on October 4 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Pat. 6,403,539 B1 has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, the rejection of claims 1, 2 and 8-17 under the judicially created doctrine of obviousness-type double patenting based on U.S. Pat. 6,403,539 B1 to Marchionni et al. and in view of Mussell et al. has been obviated.

*Allowable Subject Matter*

Claims 1-21 are allowed. The prior art of record does not teach or suggest the instant invention regarding a perfluoropolyether additive of the instant formula (I).

*Conclusion*

This application is in condition for allowance except for the matters set forth above under the "Claim Objections" section.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

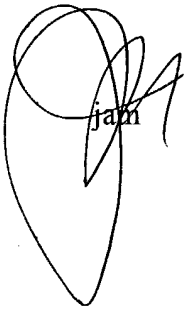
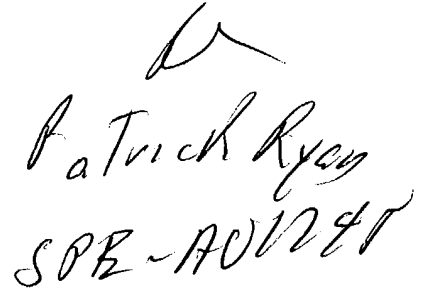
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to be "jam" or similar, enclosed within a large, loopy oval shape.A handwritten signature in black ink, appearing to be "Patrick Ryan", followed by the text "SPE-ADVERT" in a stylized, cursive font.